

REMARKS

Claims 1-18 are pending in this application.

Claims 1-18 are rejected.

The first Office Action mailed on February 25, 2004, has been received and reviewed. Claims 1-18 are pending in the application. Claims 1-18 presently stand rejected. As of this amendment, Applicants have canceled Claims 1-2, 10, and 12 without prejudice or disclaimer. Additionally, Applicants have amended Claims 3-9, 11, and 13, 14, 18. As of this amendment, Claims 3-9, 11, and 13, and 14-18 are believed to be in condition for allowance and Applicants respectfully request reconsideration of the application as amended herein.

Rejections under 35 U.S.C § 112, second paragraph

The Examiner has rejected Claims 1-18 under 35 U.S.C § 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. In 1 Y is not defined. In 3 the formula in parenthesis depicts an isobutyl and not the recited t-butyl group. In 4 'therapeutically' should be inserted before 'effective'. 'Chemically modified compound' is vague and indefinite in 10. Therapeutically effective should be inserted before 'salt' in 11. 'Prodrug' in claim 12 is vague and indefinite."

Applicants have canceled Claims 1-2, 10, and 12 without prejudice or disclaimer as of this Amendment. Applicants also have amended Claims 3-9, 11, 13, 14, and 18 as further detailed below.

Regarding Claim 3, applicants have corrected the misprint "t-butyl" by deleting it, and substituted it with the right word "isobutyl".

Regarding Claim 4, applicants have amended the claim by inserting the word “therapeutically” before “effective” to make definition of the claim clear. Also the applicants have inserted the word “An essentially pure” to the compound in the claim to limit the claim further. The applicants have changed the dependency of claim 4, which is originally depended on claim 1, which is now canceled. Now claim 4 is dependent on claim 3.

Regarding Claim 5, applicants have amended the claim by inserting the words “, wherein the composition is” in front of “in oral form” to define the claim clearly.

Regarding Claim 6, applicants have amended the claim by inserting the words “, wherein the composition is” in front of “in intravenous form” to define the claim clearly.

Regarding Claim 7, applicants have amended the claim by inserting the words “, wherein the composition is” in front of “in subcutaneous form.” after the words “claim 4” to define the claim clearly.

Regarding Claim 8, applicants have amended the claim by inserting the words “, wherein the composition is” in front of “in intramuscular form.” to define the claim clearly.

Regarding Claim 9, applicants have amended the claim by inserting the words “, wherein the composition is” in front of “in inhalation form.” to define the claim clearly.

Regarding Claim 11, applicants have inserted the words “therapeutically effective” in front of the word “salt” to define the claim clearly.

Applicants have also amended claim 11 by replacing the words “The chemically modified compound according to claim 10” with the words “The pharmaceutical composition of claim 4” to define the claim clearly and to accommodate the cancellation of claim 10.

Regarding Claim 13, applicants have inserted the words “essentially pure” in front of the word “compound”. Applicants have added the words “and purifying” after the word “extracting” to limit the claim further. Applicants have amended the claim to accommodate the cancellation of claim 1 by replacing the words “a compound as claimed in claim 1” with “an essentially pure compound of Formula II...” and the formula with its description.

Regarding Claim 14, applicants have inserted the word “therapeutically” in front of the word “effective amount”, and the words “an essentially pure” in front of the word “compound” to limit the claim further. Applicants have amended the claim to accommodate the cancellation of claim 1 by replacing the words “... with said disease an effective amount of compound as claimed in claim 1” with “... suffering with said disease with a therapeutically effective amount of an essentially pure compound of Formula I...” and the formula with its description.

Regarding Claim 15, 16 and 17, applicants believe that they are in good conditions and have not made any changes.

Regarding Claim 18, applicants have inserted the word “therapeutically” in front of the word “effective amount”, and the words “an essentially pure” in front of the word “compound” to limit the claim further. The claim language is now read as “... a therapeutically effective amount of an essentially pure compound of Formula I ...” instead of “... an effective amount of a compound as claimed in claim 1”.

Rejections under 35 U.S.C § 101

The Examiner has rejected Claims 1-3 and 18 under 35 U.S.C § 101 for not representing a new invention. The Examiner has pointed out that the compounds recited in Claims 1-3 is not new in nature while the essentially pure compound is.

Applicants have canceled Claims 1-2 without prejudice or disclaimer.

Applicants also amended Claims 3 and 18 as further detailed below.

Regarding Claim 3, applicants have added the limiting word “An essentially pure” in front of the word “compound” in the claim to make the claim specifically complying with 35 USC 101.

Regarding Claim 18, applicants have added the limiting word “An essentially pure” in front of the word “compound” in the claim to make the claim specifically complying with 35 USC 101. Applicants have replaced “... an effective amount of compound as claimed in claim 1” with “... a therapeutically effective amount of an essentially pure compound of Formula I...” and the formula with its description.

Rejections under 35 U.S.C § 102 (a)

The Examiner has rejected Claims 1-2 under 35 U.S.C § 102(a) as being anticipated by Banerji et al, Phytochemistry, vol., p. 897-901 (April 17, 2002). “It discloses the isolation and structural characterization of a compound from Piper brachystachyum Wall denoted as (4). It falls within the genus of claims 1 and 2.”

Applicants have canceled Claims 1-2 without prejudice or disclaimer.

ENTRY OF AMENDMENTS

The amendments to Claims 3-9, 11, and 13, 14, 18 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 3-9, 11, and 13-18 are believed to be in condition for allowance, and an early notice therefore is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned agent.

The commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 502869.

Respectfully Submitted,



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